

REMARKS

This is a full and timely response to the outstanding final Office Action mailed December 1, 2004. Upon entry of the amendments in this response, claims 1 – 2, 4 – 12, 14 – 22, and 24 - 37 remain pending. In particular, Applicants have amended claims 1 and 31. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Rejections Under 35 U.S.C. § 103

The Office Action indicates that claims 1 - 2, 4 - 12, 14 - 22, and 24 - 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Shaughnessy* or *Ng* and further in view of *Martin*. For at least the reasons indicated below, Applicants respectfully traverse the rejection.

With respect to *Shaughnessy* and *Ng*, each of these references discloses a system in which instructions are written onto a document that is to be scanned. The document with the written instructions is then scanned and the instructions are automatically interpreted. The instructions are used for modifying the image that was acquired during the scanning process. The instructions, however, are not saved for later display with the scanned image under the teachings of either reference. Further, if such instructions were displayed after the scanned image was processed in accordance with those instructions, the display of such instructions would be meaningless. That is, since the instructions relate, for example, to deleting a portion of the scanned image, displaying an instruction to delete a portion of the image would not make sense after that portion had already been deleted. Thus, the instructions taught in *Shaughnessy* and *Ng* do not correlate to annotations that can be selectively viewed/displayed in association with a preview image, as will be described in detail below with respect to the pending claims.

With respect to *Martin*, that reference discloses:

In one embodiment of the present invention, a user has an option to annotate the saved image file. By adding annotations to the stored image file, the user has the option of adding his or her thoughts and comments by adding notes, graphics or the like to the image file using known techniques. When the user subsequently views the stored image file, the user in one embodiment has the option of viewing the image file with the annotations displayed or without the annotations displayed. (Col. 9, lines 1.– 9).

Clearly, *Martin* involves adding annotations after a scanning operation has been performed. This is in direct contrast to the features/limitations recited in Applicants' claims. Moreover, Applicants respectfully assert that it is improper to combine the teachings of *Martin* with either *Shaughnessy* or *Ng*, because *Shaughnessy* and *Ng* merely teach the interpretation of written instructions that are not suitable for display, in contrast to the annotations recited in the pending claims.

With reference now to the claims, claim 1 has been amended to recite:

1. A system comprising:
a scanner;
a document analysis and processing software component in communication with said scanner; and
automatic annotation logic in communication with said document analysis and processing software component, said automatic annotation logic configured to detect handwriting in a scanned image and ***save said handwriting as an annotation in a document generated from said scanned image such that, when a preview image corresponding to the scanned image is displayed to a user via a display device, the annotation is not automatically displayed to the user, said automatic annotation logic being further configured to enable selective viewing of the annotation in association with the preview image.***
(Emphasis Added).

Applicants respectfully assert that the references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 1. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 103 is improper and that claim 1 is in condition for allowance. Since claims 2 and 5 – 10

are dependent claims that incorporate all the features/limitations of claim 1, Applicants respectfully assert that these claims also are in condition for allowance.

With respect to claim 11, that claim recites:

11. A method comprising:
scanning a document to acquire a scanned image;
detecting handwriting in said scanned image; and
modifying said scanned image to remove said handwriting from the scanned image such that the handwriting is not automatically displayed to an operator viewing the scanned image via a display device, the handwriting being saved as an annotation associated with said scanned image, the annotation being selectively viewable by the operator.
(Emphasis Added).

Applicants respectfully assert that the references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 11. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 103 is improper and that claim 11 is in condition for allowance. Since claims 12 and 14 - 20 are dependent claims that incorporate all the features/limitations of claim 11, Applicants respectfully assert that these claims also are in condition for allowance.

With respect to claim 21, that claim recites:

21. A computer readable medium having a program the program comprising logic for:
scanning a document to acquire a scanned image;
detecting handwriting in said scanned image; and
modifying said scanned image to remove said handwriting from the scanned image such that the handwriting is not automatically displayed to an operator viewing the scanned image via a display device, ***the handwriting being saved as an annotation associated with said scanned image, the annotation being selectively viewable by the operator.***
(Emphasis Added).

Applicants respectfully assert that the references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 21. Therefore, Applicants respectfully assert that the rejection under 35

U.S.C. § 103 is improper and that claim 21 is in condition for allowance. Since claims 22 and 24 - 30 are dependent claims that incorporate all the features/limitations of claim 21, Applicants respectfully assert that these claims also are in condition for allowance.

With respect to claim 31, that claim has been amended to recite:

31. A system for processing a document that includes a notation, said system comprising:
analysis and processing logic operative to:
receive information corresponding to a scanned document;
determine whether the information comprises a notation; and
if a notation is identified, process the information such that, when a preview image corresponding to the scanned document is displayed to the user on a display device, the notation is not automatically displayed to the user,
the analysis and processing logic being further operative to selectively display the notation in association with the preview image.
(Emphasis Added).

Applicants respectfully assert that the references, either individually or in combination, do not teach or reasonably suggest at least the features/limitations emphasized above in claim 31. Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 103 is improper and that claim 31 is in condition for allowance. Since claims 32 - 37 are dependent claims that incorporate all the features/limitations of claim 31, Applicants respectfully assert that these claims also are in condition for allowance.

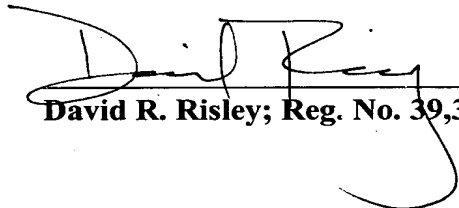
Cited Art Made of Record

The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

CONCLUSION

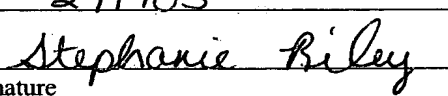
In light of the foregoing amendments, Applicants respectfully submit that pending claims 1 - 2, 4 - 12, 14 - 22, and 24 - 37 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this application, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


David R. Risley; Reg. No. 39,345

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
100 Galleria Parkway N.W., Suite 1750
Atlanta, Georgia 30339
(770) 933-9500

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on

2/1/05

Signature